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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,322	11/27/2001	Michael L. Gough	NEO1P026.US02	3459
45965	7590	03/18/2008	EXAMINER	
TECHNOLOGY & INTELLECTUAL PROPERTY STRATEGIES GROUP PC (dba TIPS GROUP) P. O. BOX 1639 LOS ALTOS, CA 94023-1639			PHAM, KHANH B	
ART UNIT		PAPER NUMBER		2166
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/997,322	GOUGH ET AL.	
	Examiner	Art Unit	
	Khanh B. Pham	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 November 2007.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 33-98 is/are pending in the application.
 4a) Of the above claim(s) 52-60,66-83 and 87-98 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,33-51,61-65 and 84-86 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/05/07 and 11/21/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Applicant's submission filed on 11/05/2007 has been entered. Claims 52-98 have been added. Claims 1, 33-98 are pending in this Application.

Election/Restrictions

3. Newly submitted claims 52-60, 66-83, 87-98 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
Group I : Claims 1, 33-51, 61-65, and 84-86; direct to method for providing audiovisual email system.
Group II: Claims 52-60; direct to method for advertising via email.
Group III: Claims 66-71, direct to method for uploading an address book to a server.
Group IV: Claims 72-77, direct to method for calculating fee to be paid.
Group V: Claims 78-80, direct to method for detecting spam.
Group VI: Claims 81-83, direct to method for displaying menu.
Group VII: Claims 87-89, direct to method for tracking and resending email.

Group VIII: Claims 90-92, direct to method for creating email having discretionary functionality.

Group IX: Claims 93-95, direct to an email including self-executing software segment.

Group X: Claims 96-98, direct to method for displaying a website within an email.

Since applicant has received an action on the merits for the originally presented invention (Group I), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 52-60, 66-83, 87-98 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

4. The disclosure is objected to because of the following informalities: The “Related Application” section on page 1 must be amended to provide current status for the related applications.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 33-51 are rejected under 35 U.S.C. 102(b)** as being anticipated by XP-002150023 (“Streaming Email”), hereinafter “**Streaming Email**”.

As per claim 1, “Streaming Email” teaches a method for providing an audiovisual e-mail system (pages 308-315, Video Express Email) comprising:

- “providing a server connected to a network” at page 309;
 (“Streaming Email” teaches the ImageMind’s Web Server connected to the Internet)
- “inputting a message and an audiovisual enhancement which is associated with said message from a sender into said server, said message to be sent as an e-mail to at least one recipient on said network” at page 309;
 (“Streaming Email” teaches the step of selecting video and audio data (i.e., “audiovisual enhancement”) to a video e-mail message)
- “associating said message with a self-executing programmable enhancement operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message” at page 9;
 (“Streaming Email” teaches that video player can be attached to the e-mail message)
- “and sending said e-mail over said network to said at least one recipient” at page 9.

As per claim 33, “Streaming Email” teaches a method as recited in claim 1 wherein “said audiovisual enhancement includes both audio and visual components” at page 309.

As per claim 34, “Streaming Email” teaches a method as recited in claim 1 wherein “said audiovisual enhancement includes only an audio component” at page 309.

As per claim 35, “Streaming Email” teaches a method as recited in claim 1 wherein “said audiovisual enhancement includes only a visual component” at page 309.

As per claim 36, “Streaming Email” teaches a method as recited in claim 1, wherein “said audiovisual enhancement includes a streaming video displayed within a window of a recipient's machine” at page 312.

As per claim 37, “Streaming Email” teaches a method as recited in claim 1 wherein “said audiovisual enhancement is developed on a sender's machine, and is transmitted to said server over said network” at page 310.

As per claim 38, “Streaming Email” teaches a method as recited in claim 37 wherein “said network includes a TCP/IP network” at page 311.

As per claim 39, “Streaming Email” teaches a method as recited in claim 38 wherein “said network includes the Internet” at page 308.

As per claim 40, “Streaming Email” teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system comprising:

- “a code segment transmitting over a network to a server an audiovisual enhancement which is associated with a message from a sender, said message to be sent as an e-mail to at least one recipient on said network” at page 309;
- “a code segment associating said message with a self-executing code segment operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message upon the selection of said message by said at least one recipient” at pages 309-313.

As per claim 41, “Streaming Email” teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein “said audiovisual enhancement includes both audio and visual components” at page 309.

As per claim 42, “Streaming Email” teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein “said audiovisual enhancement includes only an audio component” at page 309.

As per claim 43, “Streaming Email” teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein “said audiovisual enhancement includes only a visual component” at page 309.

As per claim 44, “Streaming Email” teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein “said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine” at page 312.

As per claim 45, “Streaming Email” teaches computer program segments embodied in computer readable media to provide an audiovisual e-mail system as recited in claim 40 wherein “said audiovisual enhancement is developed on a sender's machine” at page 310.

As per claim 46, “Streaming Email” teaches an audiovisual e-mail system comprising:

- “means transmitting over a network to a server from a sender machine an audiovisual enhancement which is associated with a message from said sender”, said message to be sent as an e-mail to at least one recipient on said network” at pages 310-312; and

- “means associating said message with a self-executing program operative to stream said audiovisual enhancement, at least in part, from said server over said network and to display said audiovisual enhancement in conjunction with said message on a recipient machine upon the selection of said message by said at least one recipient” at page 312-313.

As per claim 47, “Streaming Email” teaches an audiovisual e-mail system as recited in claim 46 wherein “said audiovisual enhancement includes both audio and visual components” at page 309.

As per claim 48, “Streaming Email” teaches an audiovisual e-mail system as recited in claim 46 wherein “said audiovisual enhancement includes only an audio component” at page 309.

As per claim 49, “Streaming Email” teaches an audiovisual e-mail system as recited in claim 46 wherein “said audiovisual enhancement includes only a visual component” at page 309.

As per claim 50, “Streaming Email” teaches the audiovisual e-mail system as recited in claim 46 wherein “said audiovisual enhancement includes a streaming video displayed within a window of said recipient's machine” at page 313.

As per claim 51, "Streaming Email" teaches the audiovisual e-mail system as recited in claim 46 wherein "said audiovisual enhancement is developed on said sender's machine" at page 310.

As per claim 61, "Streaming Email" teaches a method for providing active e-mail comprising:

- "receiving email text from a sender" at page 309;
- "associating said e-mail text with a code segment" at page 309;
- "sending said code segment to a recipient in a body of an e-mail" at page 309.

As per claim 62, "Streaming Email" teaches "an email server comprising a computer configured to receive e-mail text from a sender, to associate said e-mail text with a code segment and to send said code segment to a recipient in a body of an email" at page 309.

As per claim 63, "Streaming Email" teaches a computer program embodied on a computer readable media for providing active email comprising: "software segment receiving email text from a sender ; software segments associating said email text with a code segment; and software segments sending said code segment to a recipient in a body of an email" at page 309.

As per claim 64, "Streaming Email" teaches a method for providing e-mail comprising: "providing a link between an open email on a recipient computer and a

stored audio and/or video file not on said recipient computer; and streaming said audio and/or video file to said recipient computer" at pages 313-314.

As per claim 65, "Streaming Email" teaches a computer product for providing email comprising: "software segments providing a link between an open email on a recipient computer and a stored audio and/or video file not on said recipient computer; and software segments streaming said audio and/or video file to said recipient computer" at pages 313-314.

As per claim 84, "Streaming Email" teaches a method for enhancing an email comprising: "enhancing an email; and reviewing the enhancement of said email prior to sending said email" at pages 310-311.

As per claim 85, "Streaming Email" teaches an email server comprising a computer configured to enhance an email and to permit the review the enhancement of said email prior to sending said email" at pages 310-311.

As per claim 86, "Streaming Email" teaches a computer program for enhancing email comprising: "software segments for enhancing an email; and software segments for reviewing the enhancement of said email prior to sending said email" at page 310-311.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 33-51 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Examiner's Note: Examiner has cited particular page or columns and line numbers in the references applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the Claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is **(571) 272-3574** for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Khanh B. Pham/
Primary Examiner
Art Unit 2166

March 12, 2008

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